

ESTTA Tracking number: **ESTTA538047**

Filing date: **05/15/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

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|---------------------------------------|---|
| Name | Tristar Products, Inc. |
| Granted to Date of previous extension | 05/15/2013 |
| Address | 492 Route 46 East Fairfield, NJ 07004 UNITED STATES |

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| Attorney information | Daniel J. Holmander Barlow, Josephs & Holmes Ltd. 101 Dyer Street, 5th floor Providence, RI 02903 UNITED STATES djh@barjos.com, cac@barjos.com, tm@barjos.com, nkritzer@bakoskritzer.com, ebakos@bakoskritzer.com Phone:4016179778 |
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Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 85684030 | Publication date | 01/15/2013 |
| Opposition Filing Date | 05/15/2013 | Opposition Period Ends | 05/15/2013 |
| Applicant | Blue Gentian, LLC 223 Skylark Point Jupiter, FL 33458 UNITED STATES | | |

Goods/Services Affected by Opposition

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| Class 017. All goods and services in the class are opposed, namely: Garden hoses |
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Grounds for Opposition

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| The mark is merely descriptive | Trademark Act section 2(e)(1) |
| The mark comprises matter that, as a whole, is functional | Trademark Act section 2(e)(5) |
| <i>Torres v. Cantine Torresella S.r.l.Fraud</i> | 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986) |
| Genericness | Trademark Act section 23 |
| Other | Trademark Sec. 1, 2, 45 - Failure to Function as Trademark |

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| Related Proceedings | Applicant filed suit against Opposer in Civil Action No. 2:13-CV-01758, U.S. District Court of NJ, on March 21, 2013 related to alleged infringement of U.S. Pat. Nos: 8,291,941 and 8,291,942. |
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| Attachments | Complaint.pdf(205469 bytes) |
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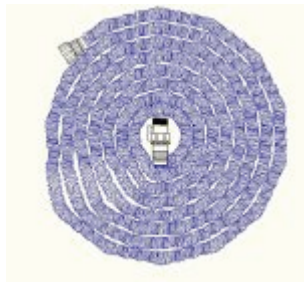
Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
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| Signature | /daniel j. holmander/ |
| Name | Daniel J. Holmander |
| Date | 05/15/2013 |

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| |) | |
| Tristar Products, Inc. |) | Opposition No. _____ |
| Opposer, |) | |
| |) | Application S.N. |
| v. |) | 85/684,030 |
| |) | |
| Blue Gentian, LLC |) | |
| Applicant |) | |
| |) | |

Opposer, Tristar Products, Inc. a corporation organized under the laws of Pennsylvania and located at 492 Route 46 East, Fairfield, NJ 07004, believes that it will be damaged by registration of the following:



(“Mark”), which Mark is the subject of U.S. Fed. Trademark Application Serial No. 85/684,030 (“Application”) filed by Blue Gentian, LLC, a corporation organized under the laws of Florida and located at 223 Skylark Point, Jupiter, Florida, 33458, and which Mark was published for opposition in the *Official Gazette* on January 15, 2013. An extension of time was

granted by the Trademark Office for Opposer to file an Opposition by May 15, 2013.

Notification of Pending Litigation

The Opposer hereby notifies the Board that Applicant previously filed a complaint for patent infringement on March 21, 2013 (prior to the filing of U.S. Trademark Application No. 85/684,030 on July 23, 2012) against Opposer based upon at least U.S. Pat. Nos: 8,291,941 and 8,291,942 and that said proceeding is currently pending. (Civil Action No. 2:13-cv-01758, U.S. Dist. Ct. of NJ)

The grounds for the opposition are as follows:

COUNT I – Section 2(e)(1) of the Trademark Act – Merely Descriptive and/or Generic

1. Applicant submits that the Mark is merely descriptive and/or generic under Section 2(e)(1) of the Trademark Act.
2. The opposed Application was filed on July 23, 2012 under Section 1(b) of the *Trademark Act* on an intent-to-use filing basis.
3. Applicant admits that Applicant's Mark describes or represents

a coiled hose as described in the Application.

4. Applicant seeks to register the Mark for garden hoses in International Class 017.
5. Opposer submits that the Mark is merely descriptive and/or generic because it describes or represents an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods, namely garden hoses.
6. Opposer submits that Applicant's description of the Mark as a coiled hose for the garden hose represents prima facie evidence that the Mark is considered merely descriptive and/or generic of the goods, garden hoses, offered by the Applicant.
7. Opposer alleges that Applicant's Mark is merely descriptive and/or generic under Section 2(e)(1) of the Trademark Act and therefore unregistrable and should be refused registration, rendered unenforceable, and/or restricted.

COUNT II – Section 2(e)(5) of the Trademark Act – Functional Refusal

1. Applicant's Mark comprises matter that, as a whole, is functional in accordance with Section 2(e)(5) of the Trademark Act.

2. U.S. Pat. No. 8,291,941 entitled “Expandable and Contractible Hose” lists, on its face, the assignee as the Applicant.
3. U.S. Pat. No. 8,291,942 entitled “Expandable Hose Assembly” lists, on its face, the assignee as the Applicant.
4. Opposer submits that U.S. Pat. No. 8,291,941 discloses the utilitarian advantages of Applicant’s Mark sought to be registered.
5. Opposer submits that U.S. Pat. No. 8,291,942 discloses the utilitarian advantages of Applicant’s Mark sought to be registered.
6. Opposer submits that Applicant’s Application for the Mark should be refused registration, rendered unenforceable, and/or restricted under Section 2(e)(5) of the Trademark Act because Applicant’s Mark is functional and further is the subject of U.S. Pat. Nos: 8,291,941 and 8,291,942 that discloses the utilitarian advantages of the Mark.

COUNT III –Trademark Sec. 1, 2, and 45 – Failure to Function as Trademark

1. Opposer submits that Applicant’s Mark is a product design

trade dress mark for a coiled hose.

2. Applicant did not submit Trademark Sec. 2(f) evidence during the prosecution of the Application to establish distinctiveness of Applicant's Mark.
3. Opposer submits that Applicant's Mark lacks distinctiveness and thereby fails to function as a trademark under Trademark Act Section 1, 2 or 45, and therefore the Application should be refused for registration, rendered unenforceable, and/or restricted.

COUNT IV - Fraud

1. Opposer submits that the Application should be refused for registration, rendered unenforceable, and/or restricted due to fraud committed by Applicant and its representative.
2. Applicant and its representative failed to disclose U.S. Pat. No. 8,291,941 during prosecution of the Application.
3. Applicant and its representative failed to disclose U.S. Pat. No. 8,291.942 during prosecution of the Application.
4. Applicant and its representative failed to disclose that Applicant's Mark is a product design trade dress mark for a

coiled hose.

5. For at least the following reasons, Applicant's failure to disclose U.S. Pat. Nos: 8,291,941 and 8,291,942 and failure to identify the Mark as a product design trade dress mark, the Opposer submits that Applicant has committed fraud in relation to the Application.

WHEREFORE, Opposer believes that it will be damaged by registration of said Mark, and prays that this Opposition be sustained in favor of Opposer, that Application Serial No. 85/684,030 be refused registration, rendered unenforceable, and/or restricted based upon at the least the grounds set forth above. The Applicant reserves the right to add additional counts beyond those recited above.

Opposer hereby appoints Barlow, Josephs & Holmes Ltd., a law firm composed of Daniel J. Holmander, Stephen J. Holmes, David Josephs, Joshua Stockwell, Mark Tetreault, all members of the bar of the State of Rhode Island, to act as attorneys for Opposer herein, with full power to prosecute said Opposition, to transact all relevant business with the Patent

and Trademark Office and in the United States Courts and to receive all official communications in connection with this Opposition.

The fee required for the Opposition for one class (\$300 USD) is set out at (2.6(a)(17) and the TTAB is authorized to charge any fees necessary for filing this Opposition to our Deposit Account 020900.

Respectfully submitted,

Tristar Products, Inc.. (Opposer)

Date: May 15, 2013

/daniel j. holmander/
Daniel J. Holmander, Esq.
Counsel for Opposer

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Providence, RI 02903-3908
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Email: djh@barjos.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **OPPOSITION** has been served on Applicant's counsel, Carl J. Spagnuolo, and Applicant, Blue Gentian, LLC., at the following addresses of record, by first class mail, postage prepaid, this 15th day of May 2013:

Applicant

Blue Gentian LLC
223 Skylark Point
Jupiter, FL 33458

Applicant's Counsel

Carl J. Spagnuolo
Mchale & Slavin, P.A.
2855 PGA Blvd
Palm Beach Gardens, FL 33410-2910